

REMARKS

After entry of the foregoing amendment, claims 3-7, 9, 12-19, 21, 26, 27, 31 and 33-36 are pending in the application. Of these, claims 3-6, 9, 12-19 and 27 are withdrawn.

The April 21 Action rejected claims 1, 7, 10, 11, and 20-32 on new art. The other pending claims have been subject to a restriction requirement.¹

Since the restriction requirement has been renewed, such restriction is now understood to be Final.

Claims 29 and 30 were rejected as anticipated by Trotta (5,595,264), and have been canceled. (Claim 31 was also said to be anticipated by Trotta, but this is believed to be a typo, as the discussion of claim 31 concerns a § 103 rejection over Trotta/Cybul.)

Claims 1, 7, 10, 11, 20, 21, 23, 24, 25, 27, 31 and 32 were rejected over Trotta in view of Cybul (6,246,997).

Trotta teaches compiling a list of items to purchase, by scanning barcodes from sample products in a store. Cybul concerns use of loyal customer data in a POS system for generating a shopping list.

Claims 1, 10, 11, 20, 23-25, and 32 have been canceled.

Regarding claim 7, neither reference teaches or suggests using data about a habit or preference exhibited by a shopper in an on-line store or virtual storefront, in connection with bricks and mortar shopping by that shopper.

The Action cites Trotta at col. 7, lines 3-20 in support of the rejection. However, that passage does not relate to any cross-domain (i.e., on-line to bricks-and-mortar) use of information. Rather, the cited passage simply notes that a shopper who buys one product

¹ The cover sheet of the Action appears to present an incorrect list of claims withdrawn from consideration (various of the noted claims were in fact examined and made the subject of art-based rejections).

in Trotta's physical store (e.g., peanut butter) may be interested in buying a related product (e.g., jelly) from that same physical store.

Moreover, contrary to the suggestion in the Action, Cybul does not teach logging shopper habit/preference information in an on-line store, and later using that information in a physical (bricks and mortar) store – as required by the claim.

Accordingly reconsideration of claim 7 is solicited.

Claim 21 has been rewritten in independent form (including limitations from claim 20).

The Action cites Trotta, Fig. 2, as teaching that certain products of potential interest are not purchased by the shopper during the visit to the bricks and mortar store. However, Fig. 2 of Trotta is not understood to so-teach. (Nor is any other part of Trotta.)

Reconsideration of claim 21 is thus solicited.

Claim 27 has been rejected, but depends from claim 3 – which was withdrawn. Thus, it has also been withdrawn.

Claim 31 has been rewritten in independent form – including limitations from claim 30.

The Action regarded Trotta as teaching fulfilling purchases as if the purchases were made online, by passing a list to a fulfiller.

Trotta is not understood to fulfill purchases “as if the purchases were made online.” Moreover, properly construed, the specification would not permit an interpretation of the claim language in which Trotta's retrieval area (in the same store) is regarded as the claimed fulfiller.

Nonetheless, applicants have amended the claim to better distinguish the art. As amended, the claim requires that the fulfiller be a third party different than the provider of the mall storefront. (Support therefor is found, e.g., in the specification at page 6, lines 3-7.)

Claim 26 stands rejected over Trotta, Cybul, Deaton (6,993,498) and Official Notice.

No explanation is given about any subject matter for which Official Notice is taken. Clarification is requested – and documentary support evidencing such fact(s) is requested to provide a complete record for possible BPAI review.

Deaton, at col. 2, lines 25-35, is cited as teaching the limitation introduced by claim 26. However, Deaton is not understood to teach the cited claim limitation.

The noted passage of Deaton states:

25 products based upon the product's performance in the marketplace. According to another embodiment of the invention, a customer may submit a shopping list and receive price information associated with the shopping list from a plurality of different stores. Such reception allows a customer to, 30 from the customer's home, comparison shop and select an appropriate store from which to actually purchase the desired products.

Other technical advantages are readily apparent to one skilled in the art from the following figures, descriptions and 35 claims.

This Deaton passage teaches on-line comparison shopping across a selection of vendors. However, it does not teach compiling a list in a bricks and mortar store of a first vendor, and later using that list in an on-line store of a second vendor, as required by claim 26.

Accordingly, reconsideration of claim 26 (now rewritten into independent form) is requested.

Claims 28 and 22 have been canceled.

Claims 33-36 are newly added to further protect applicants' inventive work. Their subject matter is closely related to features in claims already under examination, so are believed to be appropriate for examination with the claims presently under review.

Various claims have been canceled, or amended, in order to help bring the prolonged prosecution of this application to a close. However, no surrender of subject matter is intended. Applicants reserve the right to pursue such subject matter in this or related applications.

Date: August 1, 2008

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